REMARKS/ARGUMENTS

Overview

The Examiner responded in the prior Office Action as follows: rejected claims 1-10 under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of commonly-owned U.S. Patent No. 6,260,062, and rejected claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over Kasrai (U.S. Pat. No. 5,970,120) in view of Wagner (U.S. Pat. No. 5,905,908).

Applicants hereby amend claims 1-3 and add claims 11-21 in order to correct minor typographical errors and clarify the subject matter of their invention. Thus, claims 1-21 are now pending. In addition, a separate petition for a 3-month extension of time and a Terminal Disclaimer accompany this amendment.

Analysis

Double Patenting Rejection

While Applicants disagree that claims 1-10 are unpatentable over claims 1-24 of commonly-owned U.S. Patent No. 6,260,062, this rejection is mooted since the attached Terminal Disclaimer overcomes the double patenting rejection. Accordingly, Applicants request that the rejection of claims 1-10 under the doctrine of obviousness-type double patenting be withdrawn.

Prior Art Rejection

The Examiner has also rejected each of the previously pending claims 1-10 under 35 U.S.C. § 103(a) as being unpatentable over a combination of Kasrai and Wagner. However, each of the pending claims as rejected includes features and provides functionality not disclosed by either of these references. Thus, each of the pending claims as rejected and as amended is allowable.

As an overview, the present application is generally directed towards the creation and use of systems for managing a variety of network elements (e.g., microwave radio devices and fiber optic devices) in telecommunication networks. Some embodiments of the invention focus on managing multiple network element devices of varying types in multiple heterogeneous telecommunications networks, such as in situations in which the various network element devices use different communication protocols, different

commands and/or different message formats when interacting with remote devices. In addition, some embodiments define and/or use a core set of network management messages that can be used in the same manner with any of the various network element devices in order to perform defined types of network management functions for those devices.

For example, independent claim 1 as previously rejected and as amended recites "developing a core set of messages for an element management system for a telecommunications network" by "selecting . . . basic telecommunications network management functions" for use in managing a plurality of telecommunications network elements and "creating an element-independent telecommunications network management message, in a common telecommunications management message protocol, for each selected telecommunications management function". Thus, the created network management messages, which are in a common message protocol, can be used to perform any of the basic network management functions for any of the network elements in a manner independent of the specific network elements. New independent claim 13 includes similar language, and further recites that the "plurality of telecommunications network element devices" are "of multiple distinct types that support distinct sets of network management functions" and that the network management functions that are selected are "for use with all of the telecommunications network element devices" and are "a subset of the . . . network management functions" identified as available for managing the telecommunications network element devices.

Conversely, neither Kasrai nor Wagner are related to managing telecommunication network element devices of any type, let alone to managing telecommunication network devices of multiple distinct types that support distinct sets of network management functions. Instead, Kasrai is merely directed to provisioning (*i.e.*, storing information in) a database in a telecommunication network by sending generic messages that are translated into the appropriate database-specific format, while Wagner is directed at communicating data between a server and input/output (I/O) devices on a network. The Examiner has provided no indication of any teaching or suggestion in Kasrai or Wager of any telecommunication network element devices (*e.g.*, a microwave radio or telecommunication multiplexer) on a telecommunication network, nor of performing any type of telecommunication network management

functions (e.g., monitoring alarms and other problems in the devices) on such telecommunication network element devices, as is recited in the claims and described in the application. Moreover, there are no aspects of Kasrai or Wagner that appear to be related to the recited selecting of "basic telecommunications network management functions" from among the various telecommunications network management functions supported by the various telecommunication network elements. Thus, independent claim 1 as rejected and as amended is allowable over the cited prior art references for at least these reasons, as is new independent claim 13.

Moreover, the Examiner has failed to provide any reasoned basis for the rejection of independent claims 4, 7 and 10. The sum total of the Examiner's rejection for these claims is that "[p]er claims 4-10, the rejection of claims 1-3 (paragraphs 4.1 – 4.3) applies fully". However, each of these other independent claims recite several elements not present in any of claims 1-3 – thus, even if the Examiner had provided a sufficient basis for rejecting claims 1-3, any such reasoning would not apply to the different recited elements of these other independent claims. For example, claim 4 as rejected recites the following elements, none of which are present in any of claims 1-3, and claims 7 and 10 similarly recite elements not present in any of claims 1-3.

> means for receiving, from a software application, a downstream element-independent network management message selected from a core set of downstream element-independent network management messages, for transmission to a telecommunications network element;
> means for mapping the downstream element-independent network management message into a downstream element-dependent network management message, and into an element-dependent protocol, for the telecommunications network element; and
> means for transmitting the downstream element-dependent network management message to the telecommunications network element.

Thus, Applicants request that the Examiner provide an explicit basis for the rejection of these claims as required by the MPEP or timely allow the claims.

Finally, even if the Kasrai and Wagner references had in the aggregate suggested Applicants' claimed inventive techniques, the Examiner has not provided any sufficient motivation to combine Kasrai (directed at provisioning databases) and Wagner (directed to communicating data between a server and I/O devices). The only stated motivation, that Wagner's techniques would allow Kasrai to implement compatibility between different equipment types, is based solely on hindsight reconstruction from the benefits described in Applicants' disclosure (despite the Examiner's assertion, it is clear that the different users mentioned in Kasrai are not

equivalent to different types of telecommunications network element devices), and a conclusory statement about the alleged beneficial results of combining two references is insufficient to provide a motivation to combine them. According to the Manual of Patent Examining Procedure ("MPEP") and controlling caselaw, the motivation to combine references cannot be based on mere common knowledge and common sense as to benefits that would result from such a combination, and instead must be based on specific teachings in the prior art, such as a specific suggestion in a prior art reference. For example, last year the Federal Circuit rejected an argument by the PTO's Board of Patent Appeals and Interferences that the ability to combine the teachings of two prior art references to produce beneficial results was sufficient motivation to combine them, and overturned the Board's finding of obviousness because of the failure to provide a specific motivation in the prior art to combine the two prior art references.[1] The MPEP

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> The Nortrup reference describes a television set having a menu display by which the user can adjust various picture and audio functions; however, the Nortrup display does not include a demonstration of how to adjust the functions. The Thunderchopper Handbook describes the Thunderchopper game's video display as having a "demonstration mode" showing how to play the game . . . Lee appealed to the Board, arguing that . . . the prior art provided no teaching or motivation or suggestion to combine this reference [Thunderchopper] with Nortrup . . . On the matter of motivation to combine the Nortrup and Thunderchopper references, . . . review of the Examiner's Answer reveals that the examiner merely stated that both the Nortrup function menu and the Thunderchopper demonstration mode are program features and that the Thunderchopper mode "is user-friendly" and it functions as a tutorial, and that it would have been obvious to combine them.
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> When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., . . . In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.'") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). . . .
>
> With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements . . . do not adequately address the issue of motivation to combine.
> In re Sang-Su Lee, 277 F.3d 1338, at 1341-1343, (Fed. Cir. 2002).

provides similar instructions.[2] Conversely, and in a similar manner to the arguments rejected by the Federal Circuit, the Examiner's motivation to combine these two prior art references is based solely on the alleged beneficial results that would result from combining them, with no motivation from the prior art cited to support the combination. Thus, if the Examiner maintains the current rejection on the basis of the above reasoning, Applicants request that the Examiner explain with the required specificity where the Examiner finds a suggestion or motivation in the references for this combination.

The pending dependent claims include the features of those claims from which they depend, and are thus allowable for the same reasons as those claims. Moreover, the pending dependent claims also recite additional features lacking in the cited references, and are thus allowable on the basis of those features as well, although these additional features are not enumerated here for the sake of brevity.

Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the prior art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 264-6380.

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[2]

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
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> *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art*, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
> Manual of Patent Examining Procedure, § 2143 (emphasis added).

Respectfully submitted,

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

1.   (Amended) A method for developing a core set of messages for an element management system for a telecommunications network, comprising the steps of:

reviewing telecommunications network management functions for each of a plurality of telecommunications network elements;

selecting ~~the~~ basic telecommunications network management functions for managing the telecommunications network elements; and

creating an element-independent telecommunications network management message, in a common telecommunications management message protocol, for each selected telecommunications management function.

2.   (Amended) The method according to claim 1, wherein ~~more than one of~~ the ~~plurality of~~ telecommunications network elements are manufactured by different manufacturers.

3.   (Amended) The method according to claim 1, wherein ~~more than one of~~ the ~~plurality of~~ telecommunications network elements are of different equipment types.